

TSW
Docket No.: 1793.1266



ON THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Joo-ho KIM, et al.

Serial No. 10/849,522

Group Art Unit: 1752

Confirmation No. 5579

Filed: May 20, 2004

Examiner: Elizabeth D. Ivey

For: MULTI-LAYER STRUCTURE AND METHOD OF DRAWING MICROSCOPIC STRUCTURE THEREIN, OPTICAL DISC MASTER AND METHOD OF FABRICATING THE SAME USING THE MULTI-LAYER STRUCTURE, AND OPTICAL DISC MANUFACTURED USING THE OPTICAL DISC MASTER

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action mailed August 9, 2005, having a shortened period for response set to expire on September 9, 2005, the following remarks are respectfully submitted.

I. Provisional Election of Claims Pursuant to 37 CFR §1.142

Applicants provisionally elect Group I, claims 1-31, 37-51 and 64-65 drawn to a multilayered structure and a master for manufacturing a disk, in response to the preliminary restriction requirement set forth in the Office Action.

II. Applicants Traverse the Requirement

Insofar as Groups II, III and IV are concerned, it is believed that claims 32-36, 52-56, 62-63, 66-69, 57-61 and 70 are so closely related to elected claims 1-31, 37-51 and 64-65 that they should remain in the same application. The elected claims 1-31, 37-51 and 64-65 are directed to a multilayered structure and a master for manufacturing a disk and claims 32-36, 52-56, 62-63, 66-69, 57-61 and 70 are drawn to a method of making the multilayered structure and the

master disk and drawn to an apparatus for forming the disk. There have been no references cited to show any necessity for requiring restriction and, in fact, it is believed that the Examiner would find references containing both method and product claims in the same field of technology. While it is noted that the Examiner has identified different classifications for the product and method claims, it is believed that classification is not conclusive on the question of restriction. It is believed, moreover, that evaluation of the three sets of claims would not provide an undue burden upon the Examiner at this time in comparison with the additional expense and delay to Applicants in having to protect the additional subject matter recited by the Group II, III and IV claims by filing divisional applications.

MPEP §803 sets forth the criteria for restriction between patentably distinct inventions. (A) indicates that the inventions must be independent (see MPEP §802.01, §806.04, §808.01) or distinct as claimed (see MPEP §806.05-806.05(i)); and (B) indicates that there must be a serious burden on the Examiner if restriction is required (see MPEP §803.02, §806.04(a)- §806.04(i), §808.01(a) and §808.02). The Examiner has not set forth why there would be a serious burden if restriction is required.

Even if the Examiner considers claims 32-36, 52-56, 57-61, 62-63 and 66-69 to be a separate invention from claims 1-31, 37-51 and 64-65, the Applicants respectfully request the Examiner to consider claims 32-36, 52-56, 62-63 and 66-69 (Group II) together.

III. Conclusion

Upon review of references involved in this field of technology, when considering that the method recited by the Group II claims, the disk recited by the Group III claims and the apparatus for forming the disks recited by the Group IV claims are directed to a method of manufacturing the multilayered structure and to a method of manufacturing a master for the disk and elected claims 1-31, 37-51 and 64-65 are directed to the multilayered structure and the master for the disk, and when all of the other various facts are taken into consideration, it is believed that upon reconsideration of the Examiner's initial restriction requirement, all of the pending claims should be examined in the subject application.

In view of the foregoing amendments, arguments and remarks, all claims are deemed to be allowable and this application is believed to be in condition for allowance.

If any further fees are required in connection with the filing of this Amendment, please

charge the same to our deposit account number 503333.

Should any questions remain unresolved, the Examiner is requested to telephone
Applicants' attorney.

Respectfully submitted,

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